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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,292	07/30/2001	Mitsuru Ohgake	R2184.0117/P117	8277

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EXAMINER

AGUSTIN, PETER VINCENT

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/916,292	OHGAKE, MITSURU	
	<b>Examiner</b>	<b>Art Unit</b>	
	Peter Vincent Agustin	2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. A replacement drawing sheet was received on November 15, 2004. This drawing is acceptable.

### *Specification*

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors, e.g., on Page 16, line 5: "executed" should be --execute--. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Objections*

4. Claim 20 is objected to because the status identifier "Original" should be --Currently Amended--.

### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 5, 8-11 & 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "said step (h)" on line 1. There is insufficient antecedent basis for this limitation in the claim.

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Claim 8 recites the limitation “said device information and said medium information” on e.g., lines 3-4. There is insufficient antecedent basis for these limitations in the claim.

Claim 13 recites the limitation “the device information and the medium information” on e.g., line 3. There is insufficient antecedent basis for these limitations in the claim.

Claim 14 recites the limitation “said standard strategy information” on lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation “said code (h)” on line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation “said code (i)” on line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 9-11 & 14-20 are dependent upon rejected base claims.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-7, 12-16 & 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Bakx (US 5,072,435).

In regard to claim 1, Bakx discloses a method for optically recording information in a system (figure 1) comprising a recording and reading device (3) that includes a strategy part (8 & 9) for conducting a strategy when optically recording information and an information processing apparatus (5) that includes a strategy information storing part (12) storing the strategy

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information for operating said strategy part, said method comprising the steps of: (a) reading said strategy information (column 4, line 34: "adjustment data") for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus (column 4, lines 22-25); and (b) transmitting said strategy information read in said step (a) to said recording and reading device (as shown by arrows associated between 5 & 8 and 5 & 9).

In regard to claim 2, Bakx discloses the steps of: (c) storing said strategy information (column 4, lines 34-37) information of said recording and reading device and medium information of an optical recording medium (column 4, lines 26-29) to said strategy information storing part; (d) transmitting the device information and the medium information from said recording and reading device to said information processing apparatus (as shown by the arrows between elements 5 & 8); (e) reading said strategy information corresponding to said device information and medium information from said strategy information storing part in said information processing apparatus (column 4, lines 22-25); and (f) transmitting said strategy information with said medium information to said recording and reading device (as shown by arrows associated between 5 & 8 and 5 & 9).

In regard to claim 3, Bakx discloses the steps of: (g) storing standard strategy information to said strategy storing part (column 5, lines 64-66); (h) reading said standard strategy information and transferring said standard strategy information to said recording and reading apparatus when the strategy information corresponding the device information and the medium information transmitted from said recording and reading device is not stored in said strategy information storing part (column 5, line 62 thru column 6, line 1).

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In regard to claim 6, Bakx discloses that a plurality of data sets of the strategy information is stored in said strategy part (column 5, lines 58-61).

In regard to claim 7, Bakx discloses that said step (b) is conducted just before starting recording information (see figure 2, steps A13 & A18) to said optical recording medium.

In regard to claim 12, Bakx discloses a computer-readable recording medium (figure 1, element 1) recorded with program code for causing a computer to optically record information in a system comprising a recording and reading device (3) that includes a strategy part (8 & 9) for conducting a strategy when optically recording information and an information processing apparatus (5) that includes a strategy information storing part (12) storing the strategy information for operating said strategy part, said program comprising the codes for: (a) reading said strategy information (column 4, line 34: "adjustment data") for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus (column 4, lines 22-25); and (b) transmitting said strategy information read by said code (a) to said recording and reading device (as shown by arrows associated between 5 & 8 and 5 & 9).

In regard to claim 13, Bakx discloses (d) transmitting the device information and the medium information from said recording and reading device to said information processing apparatus (as shown by the arrows between elements 5 & 8); (e) reading said strategy information corresponding to said device information and medium information from said strategy information storing part in said information processing apparatus (column 4, lines 22-25); and (f) transmitting said strategy information with said medium information to said recording and reading device (as shown by arrows associated between 5 & 8 and 5 & 9).

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In regard to claim 14, Bakx discloses reading said standard strategy information and transferring said standard strategy information to said recording and reading apparatus when the strategy information corresponding the device information and the medium information transmitted from said recording and reading device is not stored in said strategy information storing part (column 5, line 62 thru column 6, line 1).

In regard to claim 4 & 15, Bakx discloses that said medium information is read and obtained from the optical recording medium (column 4, lines 26-29).

In regard to claims 5 & 16, Bakx discloses canceling transmitting said device information and said medium information (column 4, lines 29-32: note that “not necessary to carry out a new calibration procedure” corresponds to the claimed transmission of information being canceled) to said information processing apparatus when said medium information additionally provided to said strategy information stored in said strategy part corresponds to said medium information (column 4, lines 22-29) of said optical recording medium, and activates said strategy part to record to the optical recording medium (see also column 4, lines 46-50).

In regard to claim 21, this claim has limitations that are similar to those of claims 1 & 2; thus, it is rejected using the same rationale as applied against claims 1 & 2 above.

***Allowable Subject Matter***

9. Claims 8-11 & 17-20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. See the previous Office action for a statement of reasons for the indication of allowable subject matter.

*Response to Arguments*

10. Applicant's arguments filed November 15, 2004 have been fully considered but they are not persuasive.

11. In regard to claim 1, the Applicant argues that Bakx (US 5,072,435) does not disclose or suggest the step of "transmitting said strategy information". The Examiner disagrees. As noted on the rejection above, the claimed "transmitting said strategy information" is disclosed by Bakx as shown by arrows associated between 5 & 8 and 5 & 9 of Figure 1, the claimed "strategy information" corresponding to the "adjustment data" on column 4, line 34. The Applicant notes that the strategy information that is transmitted in step (b) is the strategy information that is read from the information processing apparatus in step (a), and therefore, the information itself is being transmitted, not merely its effect. The Applicant is directed to the last four lines of the abstract, which state that if adjustment data has been stored, the write means is adjusted accordingly and no new calibration procedure is performed; and column 1, lines 49-57, which describe a detection means for detecting, after insertion of a record carrier into the information recording device, whether adjustment data has been for the relevant combination of a record carrier and information recording device has been stored in the memory, the adjustment means being adapted to adjust the write means in conformity with the adjustment data in the case that adjustment data for the combination has been stored. In other words, there is a process of comparing an expected adjustment data with an adjustment data stored in the memory. This comparison must necessarily involve transmission of the strategy information (and not merely its effect) between the memory and the recording/reading device, i.e., the claimed "transmitting said strategy information read in said step (a) to said recording and reading device".



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12. On page 14, paragraph 2 of the amendment, the Applicant acknowledges the allowance of claims 8-11 & 17-20. It should be noted, however, that these claims cannot be allowed unless they are rewritten to overcome the rejections under 35 U.S.C. 112, 2<sup>nd</sup> paragraph as noted in item 11 of the previous Office Action, which rejections have neither been acknowledged nor traversed by the Applicant in the amendment of November 15, 2004.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

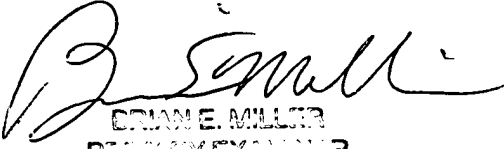
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is 703-305-8980. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 703-305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin  
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BRIANE MILLER  
PATENT EXAMINER